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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
DURAN, ARTHUR D	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/826,756	BANERJEE ET AL.	
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 April 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/4/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-28 have been examined.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 3, 5-9, 11, 13-17, 19, 21-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are rejected under 35 U.S.C. 101 because these claims have no connection to the technological arts. The method claims do not specify how the claims utilize any technological arts. For example, no network or server is specified. To overcome this rejection, the Examiner recommends that the Applicant amend the claim to specify or to better clarify that the method is utilizing a medium or apparatus, etc within the technological arts. Appropriate correction is required.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The

phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson,* 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.,* the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in

affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the current application, no technological art (i.e., computer, network, server) is being utilized by claims 1, 3, 5-9, 11, 13-17, 19, 21-24. At least one step of the body of the claims must explicitly utilize the technological arts. All steps of the body of the claims cited can be performed manually by a human without utilization of the technological arts. For example, in claim 1, the delivering can be by courier and the communicating device can be a bullhorn. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4, 5, 8-10, 12, 13, 16-18, 20, 21, 24, 25, 27, 28 are rejected under 35 U.S.C. 102(b) as being unpatentable over Gerace (5,848,396).

Claim 1, 9, 17, 25: Gerace discloses a method, system, medium for providing targeted advertising content, comprising:

detecting a change in one or more physical parameter that is representative of a local event associated with a given local environment (col 6, lines 13-21; col 22, lines 22-26; col 21, lines 49-52; col 22, lines 9-11; col 10, lines 51-65; col 8, line 51-col 9, line 7);

selecting an advertisement having a predetermined association with the local event detected (col 8, line 51-col 9, line 7; col 16, lines 42-52); and

delivering the advertisement to a local communicating device associated with the given local environment (col 16, lines 42-52; Fig. 1).

Claim 2, 10, 18: Gerace discloses the method of claim 1, wherein the local communicating device communicates with a consumer within the given environment by audio performance or video display (col 6, lines 15-21).

Claim 4, 12, 20, 28: Gerace discloses the method of claim 1, wherein the step of selecting an advertisement comprises searching a database of advertisements and events associated with the advertisements (col 16, lines 42-52; Fig. 2; Fig. 3a).

Claim 5, 13, 21: Gerace discloses the method of claim 1, wherein the local communicating device is associated with the given local environment by a factor selected from common location, common owner, or common user (col 10, line 51-col 11, line 11).

Claim 8, 16, 24: Gerace discloses the method of claim 1, further comprising:

identifying a consumer profile associated with the local communicating device, and

selecting an advertisement having a predetermined association with the local event detected and one or more aspect of the consumer profile (col 16, lines 37-55).

Claim 27: Gerace discloses the advertisement provider computer of claim 25.

Gerace further discloses that the advertising module is further configured to accept a content provider information, wherein the content provider information comprises content provider demographic information, and wherein the advertisement is selected on the basis of consumer activity and one or more additional criteria selected from the group consisting of

consumer demographic information and content provider demographic information (col 19, lines 5-32; Fig. 5a; Fig. 5c).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 3, 11, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of Kline (6,241,156) in further view of Ghori (6,243,772).

Claim 3, 11, 19: Gerace discloses the method of claim 1.

Gerace further discloses the device can be any device that utilizes a computer or a network (Fig. 1; col 3, lines 38-67).

Gerace further discloses that the device can be a computer (col 6, lines 13-21).

Gerace does not explicitly disclose the other types of devices that can be utilized.

However, Gerace discloses the utilization of the Internet (col 3, lines 50-55); radio and television (col 36, lines 49-59).

However, Kline discloses the utilization of Internet appliances and PDAs (col 3, lines 7-15)

Ghori discloses the utilization of network-connected electronic white goods (col 7, lines 25-32).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that any device that can be connected to a computer or network can be utilized by Gerace's invention. One would have been motivated to do this in order to provide more flexibility through providing more devices that can be utilized with the system.

5. Claims 6, 14, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of Kline (6,241,156) in further view of Ghori (6,243,772).

Claim 6, 14, 22: Gerace discloses the method of claim 1.

Gerace further discloses that the one or more physical parameter is selected from the group consisting of motion, position (col 10, line 51-col 11, line 12).

Gerace further discloses tracking aspects of user movement and local user environment (col 10, line 51-col 11, line 12; col 16, lines 55-67; col 17, lines 45-52), reporting and recording relevant temperatures (col 8, lines 60-65); user display preferences (col 6, lines 30-35; col 11, lines 24-56).

Gerace further discloses that any available information can be utilized for psychographic, demographic profiling and targeting (col 2, lines 1-35; col 6, lines 58-col 7, line 22).

Gerace does not explicitly disclose recording voltage, light, volume parameters.

However, Wong discloses a computer connected to a network (Fig. 1; Fig. 2) and tracking and recording user situation parameters such as light, volume, and combinations thereof (col 2, lines 50-61; Fig. 2, item 250).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Wong's further situation parameters to Gerace's user display

tracking and local environment tracking. One would have been motivated to do this in order to provide further information on user circumstances that can be utilized for psychographic, demographic profiling and targeting.

6. Claims 7, 15, 23, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396).

Claim 7, 15, 23, 26: Gerace discloses the method of claim 1.

Gerace does not explicitly disclose that the identified local event is assigned an event code.

However, Gerace further discloses that the identified local event is identified with a unique event identifiication (col 16, lines 55-67; col 16, lines 64-67).

Gerace further discloses accepting a consumer event information from the consumer (col 16, lines 50-55; col 9, lines 8-30).

Since the data is entered into respective objects and the data is also analyzed, it would be obvious to one of ordinary skill in the art to utilize codes. One would be motivated to utilize codes in order to assist with the data identification.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Chaddha (6,345,293) discloses utilizing local information for advertising;

b. Bandera (6,332,127) discloses utilizing local information for advertising;

c. Behlke (6, 107,930) discloses monitoring local conditions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AD

5/3/04